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EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 02/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/764,021

Applicant(s)

LURIE, STEVEN

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statement filed 4-30-01 (paper no. 3) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because items A-H (page 1), A-J (page 2), A-J (page 3), A-J (page 4), A-J (page 5), A-J (page 6), A-F, H-T (both page 7), A (page 9) were not received by the Examiner. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

***Claim Objections***

2. Claims 5, 6, 25, 26, 45, 46, 59, 60, 85, 86 recite "the form". There is insufficient antecedent basis for this limitation in the claim.
3. Claims 22, 23 recite "the web page". There is insufficient antecedent basis for this limitation in the claim.

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4. Claims 40, 41 recite "the connection". There is insufficient antecedent basis for this limitation in the claim.

5. Claim 42 recites "the database". There is insufficient antecedent basis for this limitation in the claim.

6. Claims 56, 96 recite "the number". There is insufficient antecedent basis for this limitation in the claim.

7. Claim 57 recites "the matching alternate service providers". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 63 recites "the initial listing". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 64 recites "the default option". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 65 recites "the missed connection". There is insufficient antecedent basis for this limitation in the claim.

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11. Claim 80 recites "the connection". There is insufficient antecedent basis for this limitation in the claim.

12. Claim 82 recites "the database". There is insufficient antecedent basis for this limitation in the claim.

13. Claim 99 recites "the method". There is insufficient antecedent basis for this limitation in the claim.

### *Drawings*

14. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first logic unit, second logic unit, third logic unit, fourth logic unit claimed in claims 1, 17, 97 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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15. The drawings are objected to because proper legend for item 160 Fig. 1 and Fig. 2 was missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “that provider” is not clearly defined. It is unclear the claimed “that provider” refers to which specific provider among the claimed “a list of service providers”.

17. Claims 57, 63, 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “sending the user to a database” is not clearly defined. It is unclear how a user (human being) can be sent to a database.

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18. Claims 58, 63, 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the service provider" is not clearly defined. It is unclear the claimed "the service provider" refers to "selected service provider" or "alternate service provider" or both claimed in claim 57.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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19. Claims 1-4, 6, 7, 17-19, 24, 26, 27, 34, 37, 38, 39, 40, 42-44, 46, 57, 58, 60, 61, 63, 64, 77, 78, 79, 80, 82-84, 86, 97, 98 are rejected under 35 U.S.C. 102(e) as being anticipated by Singh (US: 6389278).

For claims 1, 2, 4, 7, 19, 24, 27, 37, 38, 39, 40, 42, 44, 57, 58, 61, 63, 64, 77, 78, 79, 80, 82, 84, 98, regarding “a first.....that provider”, Singh teaches on column 2 line 19-29 a list of service providers is provided for the initial call.

Regarding “a second.....service provider”, Singh teaches on column 4 line 17-20 the user selects a specific service provider to initiate the call.

Regarding “a third.....service provider”, Singh teaches on column 4 line 63-66 the call is initiated from the wireless communicator to the service provider.

Regarding “a fourth.....service provider”, Singh teaches on column 5 line 25-50 when the initial call is not successfully connected, either identifying a geographic location to obtain an alternate service provider list, or obtaining from a yellow page directory that includes alternate service provider in the geographic location.

Regarding claims 3, 34, 43, 83, Singh teaches on steps 404, 406, 408, 410, 412 Fig. 4 and column 6 line 66 to column 7 line 9 yellow pages (claimed “alternate service provider”) is provided after the user has completed a communication with the selected service provider.

Regarding claims 6, 26, 46, 60, 86, Singh teaches on column 6 line 67 to column 7 line 1 the user has a conversation with the specific service provider (reads on claimed “a live person”).



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Regarding claims 17, 18, all rejections as stated in claim 1 above apply.

Singh teaches on item 105 Fig. 1A communication interface.

Singh teaches on Fig. 1A communicator (the claimed "controller computer").

Regarding claim 97, all rejections as stated in claim 1 above apply.

Singh teaches on column 6 line 66 to column 7 line 3 reconnecting to the same service provider.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 5, 25, 45, 59, 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 4 above, and in view of Salimando (US: 6563915). Singh failed to teach "the information.....recorded transmission". However, Salimando teaches on column 2 line 14-16 the service provider provides a stored (claimed "recorded") information service to telephone customers. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the "the information.....recorded transmission" as taught by

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Salimando such that the modified system of Singh would be able to support the recorded information to the system users.

21. Claims 8, 20, 21, 22, 23, 41, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 1 above, and in view of Mangetsu (US: 2002/0095359). Singh failed to teach “the user’s selection.....internet connection”. However, Mangetsu teach on sections [0061], [0065], and claim 4 page 8 selecting a particular web page (claimed “selection of a service provider”) via the internet from the communication terminal (mobile telephone). It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the user’s selection.....internet connection” as taught by Mangetsu such that the modified system of Singh would be able to support the selection over an internet connection to the system users.

22. Claims 9-15, 28-33, 35, 47-55, 67-75, 87-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 1 above, and in view of Reece et al (US: 5915214).

Regarding claims 9, 28, 47, 67, 87, Singh failed to teach “the pre-established.....service provider”. However, Reece et al teach on column 6 line 39-43 select the lowest-cost service provider. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the pre-established.....service provider” as taught by Reece et al such that the modified system of Singh would be able to support the selection based on the rate to the system users.

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Regarding claims 10, 29, 48, 68, 88, the modified system of Singh in view of Reece et al as stated in claim 9 above failed to teach “the pre-established.....provider’s rate”. However, Reece et al teach on column 13 line 5-7 and column 14 line 62-65 select the service provider based on the preset threshold price level (reads on claimed “within a predetermined range”). It would have been obvious to one skilled at the time the invention was made to modify Singh, Reece et al to have the “the pre-established.....provider’s rate” as taught by Reece et al such that the modified system of Singh, Reece et al would be able to support the predetermined range of rate to the system users.

Regarding claims 11, 30, 51, 71, 91, Singh failed to teach “the pre-established.....subject matter”. However, Reece et al teach on Fig. 7 services (voice mail, e-mail, pages, faxes) are claimed “subject matters” for consideration in selecting the service providers. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the pre-established.....subject matter” as taught by Reece et al such that the modified system of Singh would be able to support the subject matter to the system users.

Regarding claims 12, 31, 52, 74, 92, Singh failed to teach “the pre-established.....separate criteria”. However, Reece et al teach on column 12 line 19-21, column 14 line 59 to column 15 line 3 (most of column 12 line 14 to column 15 line 3) in addition to the rate, other considerations (types of service offerings) are also criteria for selecting the optimal service provider. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the pre-established.....separate criteria” as taught by Reece et al such

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that the modified system of Singh would be able to support the combination of separate criteria to the system users.

Regarding claims 13, 14, 32, 33, 49, 50, 53, 54, 69, 70, 72, 73, 89, 90, 93, 94, Singh failed to teach “a system administer establishes the set of criteria”. However, Reece et al teach on column 3 line 27-32 utilize the user-defined parameters (criteria) to select the optimal service provider. The “user” is the claimed “administrator” of the mobile communication device. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “a system administer establishes the set of criteria” as taught by Reece et al such that the modified system of Singh would be able to support the criteria established by the administrator to the system users.

Regarding claims 15, 35, 55, 75, 95, Singh failed to teach “the pre-established.....reliability factor”. However, Reece et al teach on column 12 line 53-55 in addition to other criteria for selecting the optimal service provider, the strongest signal (reads on claimed “reliability factor”) is also a criteria. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the pre-established.....reliability factor” as taught by Reece et al such that the modified system of Singh would be able to support the reliability factor to the system users.

23. Claims 16, 36, 56, 76, 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 15 above, and in view of Reece et al, Nakano (US: 2002/0193135).

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Singh in view of Reece et al as stated in claim 15 above failed to teach “the reliability.....previous users”. However, Nakano teaches on section [0037] selects a base station with the highest success call connection rate. “Official Notice” is also taken that it is old and well known to one skilled in the art that a successful connection rate refers to a ratio of the number of successful connections to total number of connection attempts between the service provider and previous users. It would have been obvious to one skilled at the time the invention was made to modify Singh, Reece et al to have the “the reliability.....previous users” as taught by Nakano such that the modified system of Singh, Reece et al would be able to support the successful connection rate to the system users.

24. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 57 above. Singh failed to teach “the selected.....service provider”. However, “Official Notice” is taken that it is old and well known in one skilled in the art that receiving a commission for referral of a customer is a common business practice. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the “the selected.....service provider” such that the modified system of Singh would be able to support the commission to the system users.

25. Claims 65, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 57 above, and in view of Dillon (US: 6067561). Singh failed to teach “the selected.....with the user”. However, Dillon teaches on column 2 line 14- 31 when the user (reads on claimed “selected service provider”) is prevented in receiving the incoming telephone

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call (reads on claimed "missed connection") an email notification is sent. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the "the selected.....with the user" such that the modified system of Singh would be able to support the email notification of missed connection to the system users.

26. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 97 above, and in view of Khazaka et al (US: 6542732). Singh failed to teach "the user.....with the user". However, Khazaka et al teach on column 1 line 27-33 a wireless telephone user may select leaving a message with a callback number for reconnection. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the "the user.....with the user" such that the modified system of Singh would be able to support the method of reconnection to the system users.

27. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singh as applied to claim 97 above, and in view of Owen et al (US: 6611501). Singh failed to teach "the user.....service provider". However, Owen et al teach on column 14 line 37-40 reserve a time for callback. It would have been obvious to one skilled at the time the invention was made to modify Singh to have the "the user.....service provider" such that the modified system of Singh would be able to support the time for reconnect to the system users.

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*Conclusion*

28. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Agre et al (US: 6208857) teach method and apparatus for performing position-and-preference-based service selection in a mobile telephone system.

29. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 703-872-9306.**

Patent Examiner

Art Unit 2645

Ming Chow



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